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JL
6/3/03
FOLEY & LARDNER
 ATTORNEYS AT LAW

 11250 EL CAMINO REAL, SUITE 200
 SAN DIEGO, CA 92130
 P.O. BOX 80278
 SAN DIEGO, CALIFORNIA 92138-0278
 TELEPHONE: 858.847.6700
 FACSIMILE: 858.792.6773
 WWW.FOLEYLARDNER.COM

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MESSAGE:

Applicant: Mark Tuszynski
 Title: MUTANT PRO-NEUROTROPHIN WITH
 IMPROVED ACTIVITY
 Appl. No.: 09/788,188
 Filing Date: 02/16/2001

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Atty. Dkt. No. 041673-2045

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark Tuszyński, et al.

Title: MUTANT PRO-NEUROTROPHIN
WITH IMPROVED ACTIVITY

Appl. No.: 09/788,188

Filing Date: 02/16/2001

Examiner: Chen, Shin-Lin

Art Unit: 1632

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**TRANSMITTAL RE FURTHER SUPPLEMENTAL RESPONSE
TO RESTRICTION REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed herewith please find Further Supplemental Response to Restriction Requirement (2 pages).

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.18, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

Respectfully submitted,

Date 5-27-03
FOLEY & LARDNER
P.O. Box 80278
San Diego, California 92138-0278
Telephone: (858) 847-6720
Facsimile: (858) 792-6773

By *Stacy L. Taylor*
Stacy L. Taylor
Attorney for Applicant
Registration No. 34,842

Atty. Dkt. No. 041673-2045

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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<i>Michelle Sympson</i> (Signature)	
May 27, 2003 (Date of Deposit)	

FURTHER SUPPLEMENTAL RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Arlington, Virginia 22313-1450

Sir:

This is in further response to a restriction requirement set forth in this application, and maintained in the Office Action of May 5, 2003.

In the Action, the Examiner has maintained the requirement for election of one of SEQ.ID Nos. 2, 4, 6 and 8 for examination. Subject to a *provisional* election of the species encompassing claims to a mutant NGF polypeptide; e.g., of SEQ. ID No. 2, Applicants respectfully maintain their traversal of the requirement on the following bases:

(1) Claim 9 confirms that SEQ.ID. Nos. 2, 4, 6 and 8 are claimed as a Markush group of alternative polypeptides. As discussed in MPEP §803.02, restriction *cannot be required* between members of a Markush grouping. The maintenance of the present restriction requirement is at odds with the restrictions imposed by §803.02.

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(2) Assuming that the restriction between SEQ. ID Nos. 2, 4, 6 and 8 would comprise an election of species, as generally permitted under §803.02, the requirement for species election would still not be proper.

First, as previously noted, a species election is only appropriate as between members of a Markush grouping if "two or more members [of the Markush group] are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 25 U.S.C. 103 with respect to the other member(s)." MPEP §803.02, third paragraph. Here, however, the mutant polypeptides of Claims 1-10 (elected Group I) all contain the same N-glycosylation sequence and the same kind of mutation in that sequence, as described. It must be appreciated that the claims do not turn on the structure of any native neurotrophins (NGF, NT3, etc.), but only a specific mutation sequence contained in each or any of them. Patentability therefore turns on a single sequence and, to that extent, SEQ. ID. Nos. 2, 4, 6 and 8 are not "unrelated and diverse" within the meaning of §803.02, third paragraph.

Second, even if the patentability of the claims could be read as turning on the novelty and non-obviousness of diverse and unrelated sequences, the 1996 examination guidelines provide for up to 10 such sequences to be examined in a single application ("It has been determined that normally ten sequences constitute a reasonable number for examination purposes.").

For all of the foregoing reasons, withdrawal of the further restriction requirement between the polypeptides/SEQ.ID. Nos. of Group I is respectfully requested. Examination of Claims 1-10, and favorable consideration thereof, is also requested.

Respectfully submitted,

Date 5-23-03

FOLEY & LARDNER
P.O. Box 80278
San Diego, California 92138-0278
Telephone: (858) 847-6720
Facsimile: (858) 792-6773

By



Stacy L. Taylor
Attorney for Applicant
Registration No. 34,842